

# Notice of Allowability

Application No.

10/535,705

Examiner

Emily Bernhardt

Applicant(s)

SHIBUYA ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 1 and 2.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date See Continuation Sheet
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

  
Emily Bernhardt  
Primary Examiner  
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Continuation of Attachment(s) 3. Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date: 5/20/05&7/25/05&2/27/06. *✓ 11/1/06*.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The application has been amended as follows to correct spelling errors noted in the claim(s) as well as specification and Abstract:

1. In claim 1 on the 1<sup>st</sup> line delete "piperadine" and insert in its place  
- - - piperazine - - - .
2. In the Abstract on the 2<sup>nd</sup> and 7<sup>th</sup> lines, delete "piperadine" and  
insert in its place - - - piperazine - - - .
3. In the specification on page 1, 2<sup>nd</sup> line and on p.3, 14<sup>th</sup> line and on  
p.4, 7<sup>th</sup> and 13<sup>th</sup> lines and on p.5, 4<sup>th</sup>, 13<sup>th</sup> and 17<sup>th</sup> lines, delete "piperadine"  
and insert in its place - - - piperazine - - - .
4. In the specification on p.9 ,8<sup>th</sup> line and on p.12,8<sup>th</sup> and 15<sup>th</sup> lines  
and on p.14 , 5<sup>th</sup> last line, delete "piperadine" and insert in its place - - -  
piperazine - - - .
5. In the specification on p.15, 6<sup>th</sup> line, delete "pyperadine" and insert  
in its place - - - piperazine - - - .

The following is an examiner's statement of reasons for allowance:

The art of record does not teach or suggest use of formylated reactant corresponding to formula (2) in the coupling with benzimidazole reactant. US'711 is made of record as it corresponds to WO'153 cited by applicants and discussed in the specification. Additionally applicants have provided comparative examples showing the higher production of final product compared to use with Boc-protected analogs even when employing industrial scale proportions of reactants. Shibuya (US'486) is cited. It is noted that the hydroxyethyl reactant that is protected is **directly** coupled with benzimidazole reactant. The thrust of Shibuya is the avoidance of using derivatized hydroxyethyl reactants given prior art problems with by-products and decomposition as set forth in col.2 and thus Shibuya is not pertinent to instant invention but rather teaches away from instant reactant (2). Nothing more pertinent was found by the examiner.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Bernhardt:eb

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12/23/06



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